ATTORNEY DOCKET

016295.1421

(DC-05148)

PATENT APPLICATION

10/659,880

FEB 1 2 2007

IN THE CAPPED STATES PATENT AND TRADEMARK OFFICE

1

In re Application of:

Gary J. Verdun et al.

Serial No.:

10/659,880

Date Filed:

September 11, 2003

Group Art Unit:

2179

Confirmation No.:

5013

Examiner:

Wong, Noble S.

Title:

SYSTEM, METHOD AND SOFTWARE FOR COMMUNICATING THE EFFECTS OF USER PREFERENCE SETTINGS IN AN INFORMATION HANDLING SYSTEM

MAIL STOP - PETITIONS

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Dear Sir:

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail No. EV352405389US addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 12, 2007.

Matt Walker

Non-Fee Petition Under 37 C.F.R. § 1.181 to Withdraw Holding of Abandonment and Re-Mail Office Action

This petition is filed in response to notification by the U.S. Patent and Trademark Office that the above-referenced patent application has been abandoned for failure to file a timely and proper reply to the Office Action dated June 28, 2006, which set a three month period for reply. This Petition under 37 C.F.R. § 1.181 is to request that the holding of abandonment be withdrawn. As indicated in the attached statement of facts, due to no fault of Applicants, Applicants never received the Office Action, and therefore, did not respond by the six-month final due date of December 28, 2006. Accordingly, the holding of abandonment is improper pursuant to M.P.E.P. § 711.03(c)II. The required showing to establish non-receipt pursuant to M.P.E.P. § 711.03(c)II is provided in the following documents:

PATENT APPLICATION 10/659,880

ATTORNEY DOCKET 016295.1421 (DC-05148)

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- 1. Counsel's Statement of Facts in Support of Petition to Withdraw Holding of Abandonment.
- 2. Copy of Notice of Abandonment mailed on January 25, 2007.
- 3. Copy of the File History Wrapper for Serial No. 10/659,880.
- Copy of the docket record dated May 26, 2006 through August 24, 2006, where the non-received Office Action would have been entered had it been received and docketed.
- 5. Copy of returned office action envelope and 1st page of office action, both of which have received stamp dates of July 13, 2006.

As the abandonment of this case was through no fault of the Applicants, it is respectfully requested that a new Office Action be mailed and the date for response to be three months from the mail date of the new Office Action, pursuant to M.P.E.P. §711.03(c)II. It is not believed that any fees are due. However, if it is determined that a petition fee or any additional fees are due, please charge these fees to Baker Botts L.L.P. Deposit Account No. 50-2148.

Respectfully submitted, BAKER BOTTS L.L.P. Attorney for Applicants

E.M. M.

Eric M. Grabski Reg. No. 51,749

Date: February 12, 2007

Correspondence Address:

Customer No. 23640

Tel. 512.322.2689 Fax 512.322.8320 ATTORNEY'S DOCKET 016295.1421

016295.1421 (DC-05148)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1

In re Application of:

Gary J. Verdun et al.

Serial No.:

10/659,880

Date Filed:

September 11, 2003

Group Art Unit:

2179

Confirmation No.:

5013

Examiner:

Wong, Noble S.

Title:

System, Method and Software for Communicating the Effects of User Preference Settings in an Information

Handling System

Commissioner of Patents P.O. Box 1450 Alexandria, Virginia 22313.1450

Dear Sir:

Counsel's Statement of Facts in Support of Petition to Withdraw Holding of Abandonment

I am a patent attorney employed with Baker Botts L.L.P ("Baker Botts"). I am listed as an attorney of record for the above-identified pending U.S. patent application entitled System, Method And Software For Communicating The Effects Of User Preference Settings In An Information Handling System filed on September 11, 2003, Application No. 10/659,880 ("the Application"). My residence and place of employment are Austin, Texas, and were so at all times relevant to the Statement of Facts. The following facts relate to the Application.

1. All mail from the U.S. Patent and Trademark Office ("the PTO") received in the Austin, Texas office of Baker Botts is routed to an Intellectual Property mail clerk. The mail clerk opens and date-stamps all received mail, and forwards each office action received from the PTO to the particular paralegal assigned to that case. The mail clerk does not record a log of received mail and therefore no such log is provided; such a log is not required according to M.P.E.P. § 711.03(c)II.

PATENT APPLICATION 10/659,880

ATTORNEY'S DOCKET: 016295.1421 (DC-05148)

2

- 2. After the received office actions are routed to the appropriate paralegals, the paralegals are then responsible for docketing the office actions. For each office action, the response due date is docketed along with any other papers due.
- 3. According to the file history wrapper for the Application maintained by Baker Botts (see Tab 3), the office action for the Application dated June 28, 2006 ("the Office Action") has not been docketed and there is no due date for the response to the Office Action. Also attached is a copy of the docket record where an entry for the Office Action -- which was not received by Baker Botts -- would have been entered had it been received and docketed (see Tab 4). The docket record under Tab 4 has been redacted to preserve client confidences. These documents indicate that the Office Action was not received by Baker Botts.
- 4. A copy of the envelope in which the Office Action was mailed from the PTO, along with the first page of the Office Action, are attached under Tab 5. As seen on the copy of the envelope, the mailing address information is missing from the envelope. As such, the Postal Service could not deliver the Office Action, and the Office Action was returned to the PTO on July 13, 2006 (as stamped on the envelope). The returned envelope -- with no mailing address -- is further proof that Applicants never received the Office Action.
- 5. As an attorney of record for the Application, I attest that the Office Action was not received by Baker Botts from the PTO. Further, I attest that I have performed a search of the Application's file jacket and all of its contents. The results of the search revealed that the office action was not in the file jacket. This further indicates that the Office Action was not received by Baker Botts.

ATTORNEY'S DOCKET: 016295.1421 (DC-05148)

PATENT APPLICATION 10/659,880

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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application for any patent issuing thereon.

Eric M. Grabski Reg. No. 51,749

Date: February 12, 2007 Telephone: (512) 322-2689

CUSTOMER NO. 23640



United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,880	09/11/2003	Gary J. Verdun	016295.1421 (DC-05148)	5013
23640 BAKER BOT	7590 01/25/2007 FS, LLP	•	EXAM	INER .
910 LOUISIA	NA Bockeled	1-24-1 Attorney BC	. WONG, N	OBLE S
noosion, i	X 77002-4995 Case	16295.1421	ART UNIT	PAPER NUMBER
	Due Date	3-25-07	2173	
	Action	etition to Review		
		Λ.	MAIL DATE	DELIVERY MODE
:	Ву	<u> </u>	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JAN 29 2007

BAKER BOTTS LLP

		10/659,880	VERDUN ET AL.
	Notice of Abandonment	Examiner	Art Unit
		Alohia C Mana	0470
	- The MAILING DATE of this communication app	Noble S. Wong	2173
,		ears on the cover sneet with the c	orrespondence address-
>	This application is abandoned in view of:		
	Applicant's failure to timely file a proper reply to the Office (a) ☐ A reply was received on (with a Certificate of N period for reply (including a total extension of time of	lailing or Transmission dated month(s)) which expired on	•
	(b) ☐ A proposed reply was received on, but it does		
•	(A proper reply under 37 CFR 1.113 to a final rejection application in condition for allowance; (2) a timely filed Continued Examination (RCE) in compliance with 37 (Notice of Appeal (with appeal fee);	nendment which places the or (3) a timely filed Request for
	(c) ☐ A reply was received on but it does not constitution final rejection. See 37 CFR 1.85(a) and 1.111. (See €	ite a proper reply, or a bona fide atte explanation in box 7 below).	mpt at a proper reply, to the non-
	(d) ⊠ No reply has been received.		
	Applicant's failure to timely pay the required issue fee and from the mailing date of the Notice of Allowance (PTOL-8).	5).	
	 (a) The issue fee and publication fee, if applicable, was), which is after the expiration of the statutory per Allowance (PTOL-85). 	received on (with a Certification of the issue fee (and	ate of Mailing or Transmission dated and publication fee) set in the Notice of
	(b) The submitted fee of \$ is insufficient. A balance	of \$ is due.	
	The issue fee required by 37 CFR 1.18 is \$ T		CFR 1.18(d), is \$
	(c) ☐ The issue fee and publication fee, if applicable, has no	t been received.	
	3. Applicant's failure to timely file corrected drawings as requestion Allowability (PTO-37).		
	 (a) ☐ Proposed corrected drawings were received on after the expiration of the period for reply. 	(with a Certificate of Mailing or Trans	smission dated), which is
	(b) ☐ No corrected drawings have been received.		
	4. The letter of express abandonment which is signed by the the applicants.	attorney or agent of record, the assi	gnee of the entire interest, or all of
	5. The letter of express abandonment which is signed by an 1.34(a)) upon the filing of a continuing application.	attomey or agent (acting in a represe	entative capacity under 37 CFR
	6. The decision by the Board of Patent Appeals and Interfere of the decision has expired and there are no allowed claim	ence rendered on and because as.	e the period for seeking court review
	7. The reason(s) below:		
	In a phone interview dated January 18, 2007, repres reply was not sent to the Office.	entative Katie Carnes at (512) 32	22-2500 confirms that a timely
	Knewdom In Krew Vu Primary Examiner		
	Rree Vu		
	Primary Examiner		
	Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw minimize any negative effects on patent term.	v the holding of abandonment under 37 C	FR 1.181, should be promptly filed to
	J.S. Patent and Trademark Office	Abandonment	Part of Paper No. 20070118

Application No.

Applicant(s)

Country Application

Friday, February 09, 2007

Page: 1

Client Matter Number: 016295.1421

Country: US

SubCase:

Client: DELL INC.

United States of America

Client Reference No: DC-05148 AU

Resp.Office: HO

Case Type: ORD

Status Date:

Application Status: Published

Application Number: 10/659880

Filing Date: 11-Sep-2003

Publication Number: 0060659A1

Publication Date: 17-Mar-2005

Patent Number:

Issue Date:

Parent/PCT Number:

Parent/PCT Date:

Parent Issue Number:

Parent Issue Date:

Tax Schedule: LE

Expiration Date:

Confirmation #:

Patent Term Adjustment: 0

Agent:

Agent Reference #:

PTO Customer Number:

Priority Number:

Historical Family No.:

New Family Number: 016295.1421.UTL

Matter:

Claims: 22

Annuity Client?: No

Tax Start Date:

Remarks: Baker Botts is not responsible for maintenance/annuity payments. Dell handles their own

maintenance/annuity payments through CPI.

09/800044 filed 05-Mar-2001

Country Application

Friday, February 09, 2007

Page: 2

List Of Actions	•		
Action(s) Due	Due Date		Action Taken
Application Mailed	12-Aug-2003	Due Date	11-Sep-2003
Assignment Filed	11-Sep-2003	Due Date	11-Sep-2003
Oath/Declaration	11-Sep-2003	Reminder	11-Sep-2003
Application Follow Up Date	11-Nov-2003	Due Date	19-Sep-2003
Filing Receipt Received	03-Dec-2003	Due Date	09-Dec-2003
Formal Drawings Due	11-Dec-2003	Due Date	11-Sep-2003
Information Disclosure Stmnt	11-Dec-2003	Reminder	11-Sep-2003
Req.Correct.Filing Receipt	21-Jan-2004	Due Date	21-Jan-2004
Assignment Filed	27-Jan-2004	Due Date	27-Jan-2004
Assignment Recorded A	27-Jan-2004	Due Date	27-Jan-2004
Return Postcard	27-Jan-2004	Due Date	13-Feb-2004
Return Postcard	27-Jan-2004	Due Date	13-Feb-2004
Assignment Filed Follow Up	11-Mar-2004	Due Date	13-Apr-2004
Assignment Recorded B	13-Apr-2004	Due Date	13-Apr-2004
Assignment Recorded C	18-May-2004	Due Date	18-May-2004
Assignment Recorded D	19-May-2004	Due Date	19-May-2004
Assignment Filed	08-Jun-2004	Due Date	08-Jun-2004
Return Postcard	08-Jun-2004	Due Date	28-Jun-2004
Follow Up Re Filing Receipt	21-Jul-2004	Due Date	20-Feb-2004
Assignment Recorded B	19-Jan-2005	Due Date	19-Jan-2005
Req.Corrected Assignment	19-Jan-2005	Due Date	19-Jan-2005
Return Postcard	19-Jan-2005	Due Date	02-Feb-2005
Assignment Filed Follow Up	08-Feb-2005	Due Date	31-Jul-2004
Information Dis Follow Up Date	11-Mar-2005	Due Date	
Notice of Publication Rec'd	17-Mar-2005	Due Date	28-Mar-2005
Corrected Assignment Follow Up	19-Jul-2005	Due Date	21-Jun-2005

Country Application

Friday, February 09, 2007

Page: 3

Petition to Revive	22-Jan-2007	Due Date	
We never received Office Action - address was printed on the envelop		rked Undelivera	ble because no
Notice of Abandonment	25-Jan-2007	Due Date	29-Jan-2007
Petition to Revive Reminder	25-Feb-2007	Reminder	
Petition to Revive Due	25-Mar-2007	Final	
Request for Status Due	21-Apr-2007	Due Date	
Per email from T. Rosson dated 4/2 action within 16 months. Move sta		ould expect to re-	ceive the 1st office

Assignment History

Assignment From	Assignment To	Assignment Date	Reel	Frame
Verdum, Gary J.	Dell Inc.	09-Sep-2003	014496	0347
Schuckle, Richard W.	Dell Inc.	08-Sep-2003	014496	0347
Unknown	Unknown	19-May-2004	014688	0876
Verdun; Schuckle	Dell Products L.P.	26-Jan-2004	014925	0280
Dell Inc.	Dell Products L.P.	12-May-2004	016161	0188

Created By: DLALLEN2

User ID: DLALLEN2

Date Created: 16-May-2003

Last Update: 29-Jun-2005

Wednesday, July 19, 2006	9, 2006	Aus S	ecretary's G	Aus Secretary's General Docket Report	t Report	Page 6 of 12
DueDate	Indicator	ActionType/ Indicator Action Due	File Number/ Country Name	Application No. <i>l</i> Filing Date	Title	Status/ Client Name
Responsible Perso	le Perso E	EGRABSKI				
5/26/2006	Due Date	US-File Application				Unfiled
		File Application	S			
		Remark				
5/26/2006	Due Date	US-File Application				Unfiled
		File Application	S			
		Remark Patent application being prepared by Robinson Vu in Houston. cg	ng prepared by Robinso	n Vu in Houston. ⋅cg		
5/26/2006	Due Date	US-File Application				Unfiled
		File Application	S			
	•	Remark Patent application being prepared by Matt Hayenga in Dallas. cg	g prepared by Matt Hay	enga in Dallas. cg		
5/26/2006	Due Date	US-File Application				Unflied
		File Application	US			
1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1		Remark Patent application being prepared by Brian Prewitt. cg	g prepared by Brian Pr	ewitt. cg		
6/2/2006	Due Date	Information Disclosure Stmnt				Pending
		Information Disclosure Stmnt	S	3/2/2006		
		Remark				
6/4/2006	Reminder	US-3 Month Office Action				Published
Con 7	W -	1 Month to Due Date	. S	10/23/2003		
Same C		Remark				
6/672006	Reminder	US-2 Month Office Action				Published
		2nd Extension	US N. TO	9/4/2002	W	
		Remark Amendment after Final Rejection received at the USBTO on 04/06/06.	Rejection received at t	he USBTO on 04/06/06	T	•
6/21/2006	Reminder	US-2 Month Office Action				Published
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Aus Secretary's General Docket Report

Page 7 of 12

DueDate	Indicator	ActionType/ Action Due	File Number/ Country Name	Application No./ Filing Date	Title	Status/ Client Name
Responsible Perso	i	EGRABSKI				
7/4/2006	Due Date	US-3 Month Office Action				Published
/		3 Month Due Date		10/23/2002		
		Remark	done 7	(131 Lave)	(e)	
7/6/2006	Reminder	US-2 Month Office Action				Published
		3rd Extension	S	9/4/2002		
		Remark Amendment after Final Rejection received at the USPTO on 04/06/06.	ejection received at the	1e USPTO on 04/06/06		
7/8/2006	Reminder	US-Notice of Appeal Filed				Published
		1 Month Reminder/Appeal Brief	US .	1/8/2003		
		Remark Todd - Please check status of pre-appeal brief.	us of pre-appeal brief	•		
		Wait to file Appeal Brief until decision on pre-appeal	ıntil decision on pre-a	ppeal.		
7/11/2006	Reminder	Review for Broad Reissue				Granted
		Romark Wood to ha	had to ha on Jose's doctor.	doctor		
7/15/2006	Due Date	US-Application Filed	1			Pending
		Application Follow Up Date	US	5/15/2006		
		Remark Filed electronically. Todd - Please confirm PTO receipt.	1 - Please confirm PT	O receipt.		
7/17/2006	Due Date	US-2 Month Missing Parts				Pending
		Filing Fees Due	US ,	4/21/2006		
		Remark / LL / Tys	De Cryston Tonders	The state		
7/17/2006	Due Date	US-2 Month Missing Parts				Pending
		Oath/Declaration Due	US	4/21/2006		
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Wednesday, July 19, 2006	9, 2006	Aus S	Aus Secretary's General Docket Ro	eneral Dock	et Report	Page 8 of 12
DueDate	Indicator	ActionType/ Action Due	File Number/ Country Name	Application No./ Filing Date	/ Title	Status/ Client Name
Responsible Perso		EGRABSKI				
7/17/2006	Due Date	US-2 Month Missing Parts				Pending
	••	Drawings	S	4/21/2006		
		Remark				
7/20/2006	Due Date	Appln Status Check (14 Mo.)		1		Pending
		Appin Status Check (14 Mo.)	S	5/20/2005		
		Remark				
7/21/2006	Reminder	US-2 Month Office Action				Published
7)		2nd Extension	S	12/10/2004		
		Remark				
7/21/2006	Due Date	Information Disclosure Stmnt				Pending
		Information Disclosure Stmnt	S	4/21/2006		
		Remark				
772772896	Due Date	US-2 Month Office Action		l		Published
,		2 Weeks To Final Date	S	9/4/2002	SIM Manufly will a	1
		Remark Amendment after Final Rejection received at the USPTO on 04/06/06.	Rejection received at t	he USPTO on 04/06/0	Z	***************************************
7/22/2006	Due Date	US-Application Filed				Pending
		Application Follow Up Date	S	5/22/2006		
		Remark Filed electronically. Todd - Please confirm PTO receipt.	odd - Please confirm PT	O receipt.		1
7/23/2006	Due Date	US-Pre-Appeal Brief				Published
· √		Pre-Appeal Brief Decision	S	1/8/2003		
		Remark Todd - Please check status of pre-appeal	tatus of pre-appeal.			
7/24/2006	Due Date	US-Application Filed				Pending
		Application Follow Up Date	US	5/24/2006		
		Remark Filed electronically. Todd - Please confirm PTO receipt.	odd - Please confirm PT	O receipt.		

Aus Secretary's General Docket Report

Page 9 of 12

Appeal		7/24/2000	SN	US-Examiner's Answer 4 Mo. Response Status Check	Due Date	8/2/2006
		Sal's docti	Pot Fre. Ja	:		٧
		4/26/2002	us ,	Review for Generic Claim		W
Published				US-Election/Restriction	Reminder	7/25/2006
		「O receipt.	odd - Please confirm P1	Remark Filed electronically. Todd - Please confirm PTO receipt.		1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1
		5/24/2006	S	Application Follow Up Date		
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		5/12/2006	S	Drawings		
Pending				US-2 Month Missing Parts	Due Date	7/24/2006
				Remark		
		5/12/2006	S	Assignment		
Pending				US-2 Month Missing Parts	Due Date	7/24/2006
		and line!	1.80c 1/19-1	Remark (1) 450		
		5/12/2006	us -	Filing Fees Due		
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		5/12/2006	S	Oath/Declaration Due		
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Status/ Client Name	Title	Application No./ Filing Date	File Number/ Country Name	ActionType/ Indicator Action Due	Indicator	DueDate
21-11		·	!			

Remark Rec'd Order dated 5/5/06 Returning Undocketed Appeal to Examiner because of IDS not considered. Waiting for correspondence from PTO - check status of correspondence. cg

Paper dated 12/29/05 - Reply Brief rec'd by USPTO 09/29/05 and entered; Brief has been forwarded to Board of Patent Appeals and Interferences. CG

Todd - check the status of the Reply Brief w/ PTO.

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Application No <i>J</i> Filing Date Title	Status/ Client Name
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Wednesday, July 19, 2006	, 2006	Aus Se	cretary's G	Aus Secretary's General Docket Repor	et Report	Page 11 of 12
DueDate	Indicator	ActionType/ Action Due	File Number/ Country Name	Application No.	Title	Status/ Client Name
Responsible Perso		EGRABSKI				
8/17/2006	Reminder	US-2 Month Missing Parts				Pending
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		Assignment Reminder	S	4/21/2006		
		Remark				
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1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1 1	•	Remark Response after Non-Final Action received at the USPTO on 04/17/06.	al Action received at the	16 USPTO on 04/17/06		
8/19/2006	Due Date	US-Final Office Action				Published
		2 Month Amendment Due Date	S	7/7/2004		
		Remark				
8/21/2006	Reminder	US-2 Month Office Action				Published
		3rd Extension	S	12/10/2004		
	6 6 9 9 9 9 9 9 9 1 1 1 1	Remark				
8/22/2006	Due Date	Information Disclosure Stmnt				Pending
		Information Disclosure Stmnt	S	5/22/2006		
	٠	Remark				
8/24/2006	Due Date	Information Disclosure Stmnt				Pending
-		Information Disclosure Stmnt	US	5/24/2006		
		Remark				
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Wednesday, July 19, 2006	2006	Aus	Aus Secretary's General Docket Report	eneral Dock	et Report	Page 12 of 12
DueDate	Indicator	ActionType/ Indicator Action Due	File Number/ Country Name	Application No./ Filing Date	Title	Status/ Client Name
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Responsible Perso	Perso Lo					
8/24/2006	Reminder	US-2 Month Missing Parts				Pending
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		Remark				
8/24/2006	Reminder	US-2 Month Missing Parts				Pending
		Filing Fees Reminder	S	5/12/2006		
		Remark				
8/24/2006	Reminder	US-2 Month Missing Parts				Pending
		Assignment Reminder	S	5/12/2006		
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8/24/2006	Due Date	Information Disclosure Stmnt	57		Jane Sandara	Pending
		Information Disclosure Stmnt	US	5/24/2006		

Remark

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Bldg/Room_ United States Patent and Trademark Office Organization_

P.O. Box 1450

Alexandria, VA 22313-1450

If Undeliverable Return in Ten Days

OFFICIAL BUSINESS PENALTY FOR PRIVATE USE, \$300

MAILED FROM ZIP CODE 22314

AN EQUAL OPPORT

UNITED STATES PATENT AND TRADEMARK OFFICE UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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